

### **Remarks**

Claims 1-6, 8 and 10-12 remain pending in the application. Reexamination and reconsideration are requested in view of the amendments herein and the remarks below.

As an initial matter, Applicant respectfully notes that in the Amendment filed on October 26, 2004, Applicant completely responded to all of the outstanding issues raised by the Examiner. As such it was understood that the case was in condition for allowance.

For reasons that are not entirely clear, the USPTO issued the Office Action of February 9, 2005, and apparently elected to conduct an additional search and raised new art rejections of the claims under 35 USC 103 over Mitchell (U.S. 4,454,691) in view of Caplette. The Examiner wrote that regarding claim 1, Mitchell disclosed a window insert (20) having an upper edge, the window insert having one or more fastening receivers (58), a mounting bracket (16) with a lower edge, the mounting bracket having a surface and one or more fasteners. The Examiner then pointed to Caplette regarding the use of optically transmissive material. The Examiner then wrote that it would have been obvious to use optically transmissive material in the structure of Mitchell to let light through the window.

Applicant would first therefore like to note a formal objection to the piecemeal examination that has apparently been applied in this case, and for which no explanation has been formally provided to Applicant. See, MPEP 707.07(g). While Applicant appreciates the fact that the Office Action of February 9, 2005 provided the Applicant with a right to respond, it nonetheless was surprising and has, in Applicant's view, unreasonably delayed prosecution of this case. Nonetheless, Applicant responds as follows.

As recited in claims 1 and 8, the present invention has been amended to clarify that it is directed at a safety device in combination with a window frame for an automobile. No new matter has been entered by this amendment. The principal reference of Mitchell is not so directed. Furthermore, claim 1 recites a window insert having an upper edge (see e.g., 28 in FIG. 1) defined to be inserted, along with the retractable glass panel window, into an upper receiving channel of the window frame

Mitchell does not disclose or suggest that his window insert 20 can be inserted, along with a retractable glass panel window into an upper receiving channel of the window frame. Mitchell's window 13 is attached to the building and the window insert covers the window. The window insert 20 of Mitchell and the window 13 are simply not designed to be inserted into an upper receiving channel of the window frame of a vehicle.

Nor does Mitchell then teach or suggest the use of weatherstripping as between his glass panel 20 and window 13. Again, they are displaced from one another and as a consequence, no weatherstripping is disclosed.

Turning to the mounting bracket, the claimed mounting bracket (see Fig. 1 for illustration purposes only) has a lower edge 22 that inserts between the retractable glass panel window 23 and weatherstripping 24 of the window frame. Mitchell's mounting bracket 16 does not contain any sort of edge that can be inserted between a retractable glass panel and weatherstripping of a window frame. Consider Mitchell's mounting bracket 16, which has a tubular rib 61 to fit within receiver 58. This is better illustrated in FIG. 8 of Mitchell.

Again, the fact that Mitchell's mounting bracket fails to contain an edge to be inserted between a retractable glass panel and weatherstripping of a window frame is understandable as Mitchell's window insert 20 and window 13 are separate and not "engaging" components.

In addition, the present claims recite that the mounting bracket has fasteners to retain the window insert. The Examiner pointed to Mitchell's mounting bracket 16 as having fasteners 32. While that is true, the fasteners 32 of Mitchell do not serve to fasten Mitchell's window insert 20. They serve to attach Mitchell's bracket 16 to the building wall.

The Examiner also correctly acknowledged that Mitchell did not show optically transmissive material, and the Examiner looked to Caplette. The Examiner then concluded that it would have been obvious for one upon review of Mitchell to consider the use of Caplette's transparent material. The rationale was that this would have been done to let light through and by creating "dead air space" in the structure of Mitchell.

Applicant respectfully disagrees. In fact, upon closer examination it is believed that Mitchell actually teaches away from the use of clear material. At column 1, lines 44-45 Mitchell states and disparages the use of clear material when writing "[t]he subject of U.S. Pat. No. 4,068,428 is simply an interior storm window."

The U.S. '428 patent discloses an insulation window mounted on window frames of buildings and is said to comprise rigid transparent plastic. Therefore, Mitchell clearly was teaching one skilled in the art that the use of two clear plastic materials with "dead air space" was not desirable and a feature that Mitchell set out to improve upon. On that note, Mitchell goes on to emphasize the use of a shutter 15 that contains a core 40 of foam material. See, col. 4, lines 25-39 of Mitchell and Fig. 5. Accordingly, upon closer examination it is not believed that

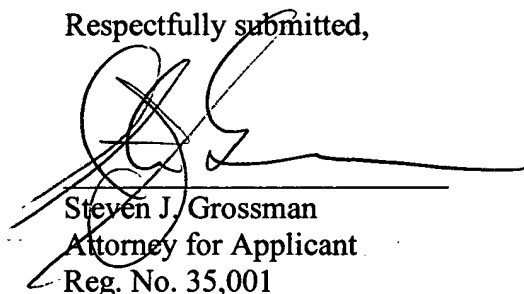
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Reply to Office Action of February 9, 2005

Mitchell is at all suggestive of the use of clear material, actually teaches away from such option, underscored by the fact that Mitchell placed foam in the shutter 15 that is opaque and not optically transmissive.

Given the above, it is respectfully submitted that the new and additional art rejections surprisingly raised in the Office Action of February 9, 2005 have been overcome. It is therefore believed that the claims are now in condition for allowance, and fully satisfy the conditions of patentability under 35 USC 103. In addition, if the Examiner desires personal contact for further disposition of this case, the Examiner is invited to call the undersigned Attorney at 603.668.6560.

In the event there are any fee deficiencies or additional fees are payable, please charge them (or credit any overpayment) to our Deposit Account No. 50-2121.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Steven J. Grossman', is written over a horizontal line. The signature is stylized with a large 'S' and 'G'.

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